

Appln No. 09/609,596
Amdt. Dated July 14, 2004
Response to Office action of May 27, 2004

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REMARKS/ARGUMENTS

Claims

The Examiner has rejected claims 1-19. By this amendment claims 1, 7, 9, 11, 17 and 18 have been amended. Therefore, claims 1-19 remain pending in the application.

Claims Rejections – 35 U.S.C. § 112

Claims 1-19 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The rejection is respectfully traversed.

The Examiner stated that the added claim limitation of “a passive laminar physical substrate” was new matter. However, the Applicants assert that an *in haec verba* recitation of the claim language in the specification is not required to satisfy the written description requirement. See, e.g., MPEP 1302.01: “It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification.”

The Applicants assert that the term “passive laminar physical substrate” does substantially correspond with the term “ordinary paper” that is recited in the specification as filed. See, for example, the specification as filed at page 10, lines 22-27, where the “forms” of the present claims are referred to as “netpages”: “*In its preferred form, the netpage system relies on the production of, and human interaction with, netpages. These are pages of text, graphics and images printed on ordinary paper, but which work like interactive web pages. Information is encoded on each page using ink which is substantially invisible to the unaided human eye. The ink, however, and thereby the coded data, can be sensed by an optically imaging pen and transmitted to the netpage system.*”

Nevertheless, in order to further prosecution of this application, the Applicants have amended the present claims 1, 7, 9, 11, 17 and 18 to substitute the phrase “form printed on a passive laminar physical substrate” with the simple phrase “form printed on paper.” Such limitation finds clear support in the passage cited above from the specification as originally filed. Thus the Applicants respectfully request that the written description rejection be withdrawn.

Claims Rejections – 35 U.S.C. § 102

Claims 1-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Montlick (US 5,561,446). The rejection is respectfully traversed.

The Applicants are disappointed that the Examiner declined to consider on the merits any of the Applicants arguments submitted in the previous response. **We note respectfully that the Examiner's failure to consider the arguments on the merits acted against USPTO policy.** See for example MPEP 2163.06: “If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). The examiner

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should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant." (Emphasis added.) The Applicants therefore respectfully request that the finality of the present office action be withdrawn. That would save the Applicants significant time and money as the Applicants would not be required to file a Request for Continued Examination (RCE) in order to learn the Examiner's position regarding the present claim amendments that attempt to distinguish the present claims over Montlick.

Montlick does not disclose or fairly suggest the claimed feature of providing a registration form printed on paper. The section of the Montlick document identified by the Examiner as anticipating the Applicants' invention (column 2, lines 63-67 and column 2 lines 1-6) states that "a selected form is displayed on the screen of the pen-based computer which requests it and data is entered through the pen-based computer by handwriting on the position sensitive display which displays the form." Thus Montlick discloses an electronic form displayed on a computer screen, which is very different from the printed paper forms of the present invention. Because a printed paper registration form is not disclosed or suggested by Montlick, it is clear that Montlick does not anticipate the Applicants' claimed invention.

It is respectfully submitted that all of the Examiner's rejections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:



PAUL LAPSTUN



KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762